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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/575,186

05/23/2000

Kia Silverbrook

NPA020US

9156

24011 7590 01/10/2007
SILVERBROOK RESEARCH PTY LTD
393 DARLING STREET
BALMAIN, NSW 2041
AUSTRALIA

EXAMINER

JUNG, DAVID YIUK

ART UNIT

PAPER NUMBER

2134

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

01/10/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 09/575,186	Applicant(s) SILVERBROOK ET AL.	
	Examiner David Y. Jung	Art Unit 2134	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 October 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-3,5-28 and 32-45 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1-3,5-28 and 32-45 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

CLAIMS PRESENTED

Claims 1-3, 5-28, 32-45 are presented.

Art Not Relied Upon

The art made of record and not relied upon is considered pertinent to applicant's disclosure. The art disclosed general background.

Response to Arguments

Applicant's arguments filed have been fully considered but they are not persuasive.

Applicant submitted his arguments at page 10 of the filing of 10/25/2006.

Regarding Johnson, Applicant stated that a coded region does not teach or suggest tags. Nevertheless, the term "tag" usually refers to any word or code that is associated with a piece of information (such as a picture, article, photo album, video clip, etc.). Thus, such coded region is considered a tag. If Applicant would choose to mean something significantly different, then Applicant is requested to amend accordingly.

Also regarding Johnson, Applicant stated that Johnson does not teach the "location" and "superimposing" of graphic information as in the claims. Even if (assuming arguendo) this is true, Sekendur clearly teaches such location and graphic information handlings (as somewhat seems noted in Applicant's discussion of

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Sekendur). See, for instance, the coded data mentioning the coordinates and position data.

Regarding Sekendur, Applicant stated that Sekendur does not teach handling form identity. Even if (assuming arguendo) this is true, Johnson clearly teaches such form handling. See, for instance, the form composer.

CLAIM REJECTIONS

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3, 5-28, 32-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ikeda (cited by Applicant, Abstract of Japan Patent Application number 08305112), Johnson (cited by Applicant, European Patent Application number 91304880.7, Publication number 0459793A1), and Sekendur (cited by Applicant, WIPO PCT International Application Number PCT/US/95/16913, International Publication Number WO 97/22959).

Regarding claim 1, Ikeda teaches a "photo album." See solution section (i.e. album editor 1 using photograph data).

Ikeda is not explicit about other features.

Johnson teaches "A method of enabling the creation and use of a ... via at least one ... form printed on a surface, the ... form containing graphic information relating to a ... activity and superimposed plurality of tags, each tag containing dot code identifying the ... form and the tag's own ...

on the ... form ...

said indicating data regarding the identity of the ... form (column 4, line 18 to column 6, line 39, i.e. forms which "facilitate proper location of markings" – e.g., column 6, line 34)."

Ikeda and Johnson are not explicit about other features.

Sekendur teaches "... own location ...

the method comprising the steps of: receiving, in a computer system, indicating data from a sensing device operated by said user,

...

and a position of the sensing device relative to the ... form, the sensing device, when placed in an operative position relative to the ... form, generating the indicating data by sensing at least some of the dot code; and identifying in the computer system and from the indicating data, at least one parameter relating to the ... activity (page 4 to page 6, first paragraphs, i. e., position related coding means, writing surface, etc.)."

Ikeda (at Solution section) and Johnson (at column 6, line 34) and Sekendur (at first two paragraphs of page 3) all teach to combine the teachings with such other image handling devices for the motivation of providing ease for the user.

It would have been obvious at the time of the claimed invention to combine teachings of Ikeda, Johnson, Sekendur so as to teach the claimed invention for the motivation noted in the previous paragraphs.

Regarding claim 26, Ikeda teaches a “photo album.” See solution section (i.e. album editor 1 using photograph data).

Ikeda is not explicit about other features.

Johnson teaches “A system for enabling the creation and use of a ... via at least one ... form printed on a surface, the ... form containing graphic information relating to a ... activity and including a plurality of tags, each tag containing a dot code identifying the ... form and a location of that tag on the ... form (column 4, line 18 to column 6, line 39, i.e. forms which “facilitate proper location of markings” – e.g., column 6, line 34).”

Ikeda and Johnson are not explicit about other features.

Sekendur teaches “said system comprising:

“a computer system for receiving indicating data from a sensing device operated by a user involved in the ... activity; said indicating data regarding the identity of the ... form and a position of the sensing device relative to the ... form, the sensing device, when placed in an operative position relative to the ... form, sensing the indicating data using at least some of the dot code, said computer system including means for identifying, from the indicating data, at least one parameter relating to the ... album activity (page 4 to page 6, first paragraphs, i. e., position related coding means, writing surface, etc.).”

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Ikeda (at Solution section) and Johnson (at column 6, line 34) and Sekendur (at first two paragraphs of page 3) all teach to combine the teachings with such other image handling devices for the motivation of providing ease for the user.

It would have been obvious at the time of the claimed invention to combine teachings of Ikeda, Johnson, Sekendur so as to teach the claimed invention for the motivation noted in the previous paragraphs.

Regarding claims 2-3, 5-25, 27-28, 32-45, the limitations specific to these claims have been discussed in the previous Office Actions. For the reasons stated therein, these claims are not patentable.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Points of Contact

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to:

(571) 273-8300, (for formal communications intended for entry)

Or:

(571) 273-3836 (for informal or draft communications, please label "PROPOSED" or "DRAFT")

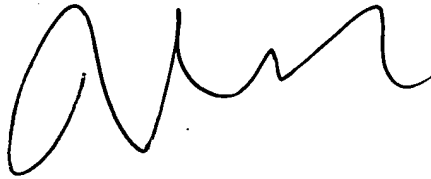
Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Jung whose telephone number is (571) 272-3836 or Jacques Louis-Jacques whose telephone number is (571) 272-6962.

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David Jung

Patent Examiner

1/7/07

A handwritten signature in black ink, appearing to be 'DJ', written over a horizontal line.